

PATENT

Atty Docket No.: 10017259-1

App. Ser. No.: 09/941,267

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the claim amendments and following remarks. By virtue of the amendment, claims 1-24 are pending in the present application of which claims 1, 3 and 11 are independent and claims 19-24 are newly added.

Claims 1-3, 9-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradbury (5,226,540) in view of Bogert (6,062,357). Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradbury and Bogert as applied to claim 3 and further in view of Bernard (5,675,524) and Lee (5,870,624). Claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradbury, Bogert, Bernard and Lee as applied to claim 4 and further in view of Inagaki et al. (6,504,529). Claims 7 and 14-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradbury and Bogert as applied to claim 3 and further in view of Kikinis (5,870,624). Claims 8 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradbury and Bogert as applied to claim 3 and further in view of Ma (5,880,928). These rejections are respectfully traversed for at least the reasons set forth below.

PERSONAL INTERVIEW CONDUCTED

The applicant wishes to thank Examiner Bell for granting the personal interview conducted on May 11, 2004. During the interview, it was agreed that none of the references teach or suggest the display and scanner assembly shown in figure 1 of the present application where the display is rotatably connected to an enclosure for the scanner. It was

also agreed that none of the references teach or suggest rotatably connecting a cover between the display and scanner, which is also shown in figure 1.

Claim Rejections Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 1-3 and 9-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradbury in view of Bogert. Of these claims, claim 1, 3, and 13 are independent. Claim 1 recites,

... a scanning module arranged in the enclosure ... a display connected to the enclosure using a rotatable connector, wherein the display is operable to be rotated on the rotatable connector to an open position to view information on the display and is operable to be rotated on the rotatable connector to a closed position where information on the display is not viewable, and in the closed position the display substantially covers a portion of the scanning module.

Neither Bradbury nor Bogert teach or suggest this feature. Bradbury (5,212,628) discloses a case 1 housing a computer 100 and other peripherals. The computer 100 is shown in figure 5 including a display 102. The display 102 is connected to an enclosure for the computer 100. However, Bradbury fails to teach or suggest a scanning module arranged in the enclosure for the computer 100. Instead, Bradbury discloses peripherals 30-34 shown in figure 1 provided in the case 1 outside the computer 100. In addition, Bradbury fails to teach or suggest "in the closed position the display substantially covers a portion of the scanning module." In Bradbury, when the display 102 is in a closed position, the display 102 appears to cover a keyboard and not a scanning module. Bradbury discloses a printer 200 shown in figure 3 in a stacked arrangement below the computer 100, but Bradbury fails to teach or suggest a display substantially covering a scanning module.

During the interview, Examiner Bell suggested he may use Lee (6,219,229) as a primary reference in future rejections. Lee, however, also fails to teach or suggest the features of claim 1. Lee discloses a display 3 pivotable on the case 1, as shown in figure 3. However, the display of Lee does not provide the claimed closed position of the display. Furthermore, the display of Lee does not substantially cover a scanning module. Accordingly, none of the references teach or suggest all the features of claims 1, 2, and 19-20.

Independent claim 3 recites,

... a scanning module, disposed in the system enclosure ...the flat screen display being rotatably coupled to the system enclosure allowing the flat screen display to be viewable in an open position and to rest on the top of the system enclosure in a closed position, wherein in the closed position the display substantially covers a portion of the scanning module.

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As described with respect to the rejection of claim 1, Bradbury discloses a display 102 connected to an enclosure for a computer 100. However, Bradbury fails to teach or suggest a scanning module arranged in the enclosure for the computer 100. Instead, Bradbury discloses peripherals 30-34 shown in figure 1 provided in the case 1 outside the computer 100. In addition, Bradbury fails to teach or suggest “in the closed position the display substantially covers a portion of the scanning module.” Lee also fails to teach or suggest all the features of claim 3. Independent claim 13 recites features similar to claim 1 and is believed to be allowable for at least the reasons claim 1 is believed to be allowable. Accordingly, claims 3-18 and 21-24 are also believed to be allowable.

In addition to the combination of Bradbury and Bogert failing to teach or suggest all the features of independent claims 1, 3, and 13, it would have not been obvious to combine Bogert with Bradbury. The Official Action states that “It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Bradbury case to have wheels and a retractable handle as taught by Bogert because Bogert provides the motivation for using the features to improve the Bradbury apparatus.” The Official Action states the motivation is to “enable the weight of the bags to be carried on the wheels” and the “handle extends to a convenient reach when in use and retracts out of the way when not in use.” However, this motivation is improper, especially in light of the Bradbury disclosure. Bradbury discloses a rugged air and water tight case to be used in a hostile environment. See Bradbury (5,226,540), column 1, lines 29-41. This suggests that the case is used in an outdoor environment where the wheels of Bogert would prove useless. Furthermore, a retractable handle would be ill suited in an air and water tight case because it would be difficult, if not impossible, to seal a case having a retractable handle. In fact, the case from

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the Bradbury disclosure would not function as was intended in light of modifications from the Bogert disclosure.

In the Official Action, on page 11, Examiner Bell alleged that the main objective of Bradbury can be maintained when making the modifications of adding a retractable handle. The Official Action states, "The modification would be done by simply having a separate inner chamber that jets into from the side into the main chamber ..." Firstly, it is unclear how using a second chamber would create an air and water tight seal. The handle would still have to retract into the second chamber resulting in an air or water tight seal being broken. Secondly, none of the cited references teach or suggest using a second chamber for a retractable handle. Accordingly, there is no reasonable expectation of success, because the combination of the retractable handle of Bogert with the case of Bradbury results in the case of Bradbury not being usable for its disclosed intended use.

In addition it should be noted that the rejection of dependent claims 5 and 6 combines five different references to create a combination that teaches the claimed invention. This rejection is clearly a hindsight rejection. Furthermore, the case of Bradbury is a portable case. None of the references teach or suggest how all the features of claims 5 and 6 allegedly taught by the five combined references would be arranged to fit into the portable case of Bradbury. For at least these reasons claims 1-24 are believed to be allowable.

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Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

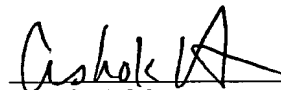
Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Cuc Hong

Dated: May 21, 2004

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